



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY, DOCKET NO.	CONFIRMATION NO.
10/084,403	02/25/2002	Daniel R. Salmonsens	156374-0008 (PA-1253)	6877

51414 7590 01/22/2007
GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
EXCHANGE PLACE
BOSTON, MA 02109-2881

EXAMINER

GUILL, RUSSELL L

ART UNIT PAPER NUMBER

2123

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/084,403

Applicant(s)

SALMONSEN ET AL.

Examiner

Russ Guill

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 9, 10, 12-16, 19-23, 25, 26, 28, 30-32 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7, 9, 10, 12-16, 19-23, 25, 26, 28, 30-32 and 35-42 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to an Amendment filed November 17, 2006. Claims 1, 2, 8, 11, 17, 18, 24, 27, 29 and 33 - 34 were previously canceled. No claims were added or canceled. Claims 3 - 7, 9 - 10, 12 - 16, 19 - 23, 25 - 26, 28, 30 - 32 and 35 - 42 are pending. Claims 3 - 7, 9 - 10, 12 - 16, 19 - 23, 25 - 26, 28, 30 - 32 and 35 - 42 have been examined. Claims 3 - 7, 9 - 10, 12 - 16, 19 - 23, 25 - 26, 28, 30 - 32 and 35 - 42 have been rejected.
2. This Office Action is NON-final due to new rejections under 35 USC § 101.
3. As recited previously, the Examiner would like to thank the Applicant for the well-presented response, which was useful in the examination process. The Examiner appreciates the effort to perform a thorough analysis, and make appropriate arguments and amendments.

Response to Remarks

4. Regarding claims 35 and 40 objected to for minor informalities:
 - 4.1. Applicants' amendments to the claims overcome the objections, and the objections are withdrawn.
5. Regarding claims 3, 9, 10, 14 - 16 and 38 - 39 rejected under 35 USC § 112:
 - 5.1. Applicants' amendments to the claims overcome the rejections, and the rejections are withdrawn.
6. Regarding independent claims 35 and 40 rejected under 35 USC § 103:
 - 6.1. Applicant's arguments in conjunction with the claim amendments have been fully considered and are persuasive. Accordingly, the rejections are withdrawn.

Claim Objections

7. Claim 35 is objected to for the following minor informalities: Regarding claim 35, lines 10 - 11, the claim recites, "providing it". It is unclear exactly what "it" is. For the purpose of claim examination, the phrase is interpreted as, "providing the converted content".

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 3 - 7, 9 - 10, 12 - 16, 19 - 23, 25 - 26, 28, 30 - 32 and 35 - 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9.1. Regarding claims 3 - 7, 9 - 10, 12 - 16 and 35 - 39, the recited system appears to perform abstract operations such as converting content. Therefore, to be statutory, the claim must be directed to a practical application producing a concrete, useful and tangible result. The claims do not appear to produce a tangible result needed to support a practical application. Although content is rendered, the rendered content is not actually displayed for viewing or listening. Under a broad interpretation, "presentation" of the content would not appear to be necessarily tangible.

9.2. Regarding claims 19 - 23, 25 - 26, 28, 30 - 32 and 40 - 42, the recited method appears to perform abstract operations such as reading content and rendering content. Therefore, to be statutory, the claim must be directed to a practical application producing a concrete, useful and tangible result. The claims do not appear to produce a tangible result needed to support a practical application. Although content is rendered, the rendered content is not actually displayed for viewing or listening.

Allowable Subject Matter

10. Any indication of allowability is being held in abeyance pending the resolution of the outstanding rejections.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure:
- 11.1. Ireton (U.S. Patent 7,043,479) teaches a media player that checks for content available in the player, and if the content is not available, retrieves the content from another source.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russ Guill whose telephone number is 571-272-7955. The examiner can normally be reached on Monday - Friday 9:00 AM - 5:30 PM.
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached on 571-272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist: 571-272-2100.
14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RG

Russ Guill
Examiner
Art Unit 2123


PAUL RODRIGUEZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100
1/17/07